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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,930	01/26/2001	Wayne L. Pushka	24,757 USA)	8224

7590 11/03/2004

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EXAMINER
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HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/770,930

Applicant(s)

PUSHKA, WAYNE L.

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1-2, 14-15, 27, 36, and 40 are objected to because of the following informalities: The use of bullet points in the claims is improper. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-13 are rejected under 35 U.S.C. 101 because, the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

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In order to overcome the 101 rejection above, the following preamble is suggested:

-A computer implemented method for ---, or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Wallman (6,360,210).

Wallman discloses a method and corresponding system and medium for managing a portfolio comprising optimizing investment performance of an economic entity, providing on an investment date, a first account in a first regulatory environment, the first account owning an investment portfolio, providing a second account in a second regulatory environment, transferring market risk but not credit risk from the first account to the second account through a counterparty, and recognizing one of gains and losses in said second account at a future date from the investment date (col.8, line 35 to col.12, line 22); transferring market risk but not credit risk from the first account to the

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second account through a counterparty is accomplished by entering into a first derivative transaction between the first account and a first counterparty whereby market risk is transferred to the first counterparty, and entering into a second derivative transaction between the second account and a second counterparty whereby market risk is transferred to the second account from the second counterparty (col.8, line 35 to col.12, line 22); the first counterparty and the second counterparty are separate counterparties (col.8, line 35 to col.12, line 22); the first counterparty and the second counterparty are the same counterparty (col.8, line 35 to col.12, line 22); the derivative transaction between the first account and the counterparty is carried out through an intermediary (col.8, line 35 to col.12, line 22); the intermediary is a counterparty selected from the group consisting services company, a trust, a limited partnership, an organization that issues securities and enters into derivative contract agreements and an organization that manages funds on behalf of a third party of a fund manager, a bank, a mutual fund, and a financial institution (col.8, line 35 to col.12, line 22); transaction is guaranteed by a third party guarantor (col.8, line 35 to col.12, line 22); the first derivative transaction is selected from the group consisting of a forward contract, an option contract, a collar contract and a derivative contract that transfers market risk (col.8, line 35 to col.12, line 22); the second derivative transaction is selected from the group consisting of a forward contract, an option contract, a collar contract and a derivative contract that transfers market risk (col.8, line 35 to col.12, line 22); the counterparty is selected from the group fund, a financial services company, a trust, a limited consisting of a bank, a mutual fund, partnership, an organization that issues

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securities and enters into derivative contract agreements and an organization that manages funds on behalf of a third party (col.8, line 35 to col.12, line 22); first account owns the investment portfolio indirectly through the ownership of an investment unit (col.8, line 35 to col.12, line 22); the future date from the investment date is at least one year (col.8, line 35 to col.12, line 22); first and second derivative transactions are reverse transactions (col.8, line 35 to col.12, line 22); a data processing system for managing the investment performance of an economic entity having a first account in a first regulatory environment and a second account in a second regulatory environment, said first account having an investment portfolio on an investment date, the system comprising a data processor for processing data relating to a transfer of market risk but not credit risk from the first account to the second account through a counterparty and a computer for storing data relating to assets in the first and second accounts and calculating one of gains and losses in the value of assets in said second account at a future date from the investment date (col.8, line 35 to col.12, line 22); and a computer readable storage medium containing computer executable code for instructing a computer to operate for storing data relating to a first account in a first regulatory environment, the first on an investment date, account owning an investment portfolio on an investment date, storing data relating to a second account in a second regulatory environment, processing data relating to a first derivative transaction between the first account and a first counterparty whereby market risk is transferred to the first counterparty, processing data relating to a second derivative transaction between the second account and a second counterparty whereby market risk is transferred to the

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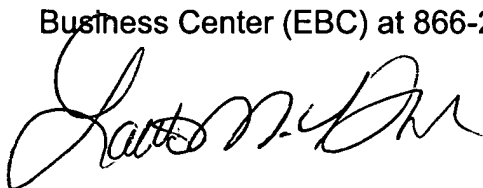
second account from the second counterparty, and calculating one of gains and losses in said second account at a future date from the investment date (col.8, line 35 to col.12, line 22).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH